

## **REMARKS**

### **I. SECTION 1 – RESTRICTION REQUIREMENT**

The Examiner has required restriction to one of the following inventions pursuant to 35 U.S.C. 121:

I. Claims 1-18, drawn to the exercise device, classified in class 482, subclass 106.

II. Claims 19-24, drawn to the method of forming an exercise device, classified in class 482, subclass 106.

The Examiner's position is that the inventions are patentably distinct from each other for the reasons given in the Examiner's detailed action.

Applicants hereby elect the invention in Group I, Claims 1-18, without traverse.

Group II, Claims 19-24, are not elected by the Applicants.

### **II. FOREIGN PATENT REFERENCES AND FOREIGN-LANGUAGE ABSTRACTS**

Applicants respectfully traverse the Examiner's rejection of claims 1 through 18 under 35 U.S.C. 103(a), as being unpatentable over several issued U.S. Patents in view of Lefebvre, FR 1,263,930, and claims 8 and 9 under 35 U.S.C. 103(a), as being unpatentable over Brice, U.S. Patent No. 5,628,716, in view of Pinard, FR 2,600,541, because the Examiner has relied entirely upon English-language translations of the abstracts of these two French patents. "Citation of an abstract without citation and reliance on the underlying scientific document itself is generally inappropriate where both the abstract and the underlying document are prior art." Ex parte Jones, 62 U.S.P.Q. 2d 1206, 1208 (B.P.A.I. 2001). To determine whether the French patents cited by the

Examiner and the English abstract of Pinard are prior art, §706.02 of the M.P.E.P. requires that “a copy of the underlying document must be obtained and analyzed. If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection.” The Board of Patent Appeals and Interferences has recognized that “[a]bstracts often are not written by the author of the underlying document and may be erroneous.” Ex parte Jones, 62 U.S.P.Q. 2d 1206, 1208 (B.P.A.I. 2001). Therefore, proper examination of the present patent application under 37 C.F.R. 1.104 should be based upon the underlying document, in this case, the two French patents, and translations of those documents. “[T]he preferred practice is for the examiner to cite and rely on the underlying document.” Ex parte Jones, 62 U.S.P.Q. 2d 1206, 1208 (B.P.A.I. 2001). The Applicants hereby respectfully request that the Examiner provide English-language translations of the French patents cited in the current office action so that the Applicants may review those documents to determine whether they render the Applicants’ invention obvious under 35 U.S.C. 103(a).

### **III. SECTION 7 – REJECTION OF CLAIMS 1, 2, 4, 6, 9, AND 11**

The Examiner's office action rejection of claims 1, 2, 4, 6, 9, and 11 under 35 U.S.C. § 103(a), as being unpatentable over Brice, U.S. Patent No. 5,628,716, in view of Lefebvre, FR 1,263,930, is respectfully traversed. As stated by the Examiner on page 4 of the Office Action, “Brice does not disclose each weight comprising an interior element providing tight tolerance with the handle, the interior element having a circumference, and a generally central void of a shape complementary to the geometric shape of the

handle,” as is claimed by the Applicants in claim 1 of the application. In In re Fritch, 972 F.2d 1260 (Fed. Cir. 1992), the Federal Circuit Court of Appeals stated that “[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” The Applicants cannot determine if the prior art suggested the desirability of the modification because Lefebvre is written entirely in French and the Examiner has not provided the Applicants with an English-language translation of that reference. Moreover, on page 5 of the Office Action, the Examiner states that “it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the weight plate of Brice with the interior element of Lefebvre, in order to provide reinforcement to the hub of the weight plate.” Clearly, by this language, the Examiner is attempting to apply the “obvious to try” test to the Applicants’ invention in determining whether said invention is obvious under 35 U.S.C. § 103(a).

Regarding the “obvious to try” test, the Court of Customs and Patent Appeals has previously stated:

[A]pplication of the “obvious to try” test would often deny patent protection to inventions growing out of well-planned research which is, of course, guided into those areas in which success is deemed most likely. These are, perhaps, the obvious areas to try. But resulting inventions are not necessarily obvious. Serendipity is not a prerequisite to patentability. Our view is that “obvious to try” is not a sufficiently discriminatory test.

In re Lindell, 385 F.2d 453 (C.C.P.A. 1967). Therefore, the Examiner’s assertion that the Applicants’ invention is obvious due to the Examiner’s own belief, in hindsight, that the Applicants’ use of the interior element to provide tight tolerance with the handle having a circumference and a generally central void of a shape complementary to the geometric

shape of the central handle was obvious to try does not set forth a sufficiently discriminatory test upon which the Examiner may rely to reject the Applicants' claims under 35 U.S.C. § 103(a). The Examiner may not use as an element of the obvious rejection that one of ordinary skill in the art would have arrived at the invention by trying different alternative structures or materials, such as the interior element with a central void having a shape complementary to the shape of the central handle used in the present invention. Thus, the Examiner's rejection of claims 1, 2, 4, 6, 9, and 11 under 35 U.S.C. § 103(a) cannot be sustained.

#### **IV. SECTION 8 – REJECTION OF CLAIM 5**

Similarly, the Examiner's office action rejection of claim 5 under 35 U.S.C. § 103(a), as being unpatentable over Brice, U.S. Patent No. 5,628,716, in view of Lefebvre, FR 1,263,930, and further in view of Kestila, U.S. Patent No. 6,336,894, is respectfully traversed. As stated by the Examiner on page 5 of the Office Action, Brice does not disclose the Applicants' claimed "weight further comprising a centrally located recession on the outside surface at least the circumference of the washer." The Federal Circuit has determined that "[t]he claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick, Co., 730 F.2d 1452, 1462 (Fed. Cir. 1984). The fact that a patent application discloses and claims a combination of features previously used in three separate devices, as alleged by the Examiner in the present case, is, alone, not fatal to patentability. The Examiner has not indicated where in the prior art there exists a

suggestion or incentive to make the modification as described by the Examiner. “Obviousness cannot be established by combining the teachings of prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.” ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577 (Fed Cir. 1984). The Examiner has not shown the Applicants any such suggestion or incentive in the prior art of record. Rather, the Examiner has relied upon recitations of elements disclosed in the prior art as well as statements that the Applicants’ invention would have been obvious to one having ordinary skill in the art without further explanation. Neither the Examiner nor “[t]he board [can] rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which [they rely].” In re Lee, 277 F.3d 1338, 1345 (Fed Cir. 2002). When an Examiner’s rejection of a claim or claims is not specific as to how one of ordinary skill in the art would have found it obvious to make the combination or modification presented by the Examiner within the rejection, the Examiner will have failed to establish a prima facie case of obviousness. Ex parte Humphreys, 24 U.S.P.Q.2d 1255, 1262 (B.P.A.I. 1992). Thus, the Examiner’s rejection of claim 5 under 35 U.S.C. § 103(a) cannot be sustained.

#### **V. SECTION 9 – REJECTION OF CLAIM 3**

The Applicants hereby respectfully traverse the Examiner's office action rejection of claim 3 under 35 U.S.C. § 103(a), as being unpatentable over Brice, U.S. Patent No. 5,628,716, in view of Lefebvre, FR 1,263,930, and further in view of Landfair, U.S.

Patent No. 6,099,443. On page 6 of the Office Action, the Examiner rejects claim 3 on the basis that welding of a weight to the end of a handle is old in the art as disclosed by Landfair. The Examiner also states that Brice does not disclose welding the interior element to the end of the dumbbell handle. First, the Applicants do not claim the use of welding to secure a weight to the handle of a dumbbell as stated by the Examiner, but rather, the Applicants claim welding the means for securing one or more weights, which comprises the interior element as stated in claim 3, to the end of the handle of the dumbbell. In claim 3, the Applicants claim only the welding of the interior element, or means for securing as illustrated by item number 20 in Figures 2, 3, and 4 of the drawings, to the ends of the handle of the dumbbell.

Moreover, the Applicants' invention is not obvious merely because old elements are used to solve a different problem. The Applicants have claimed welding the interior elements to the ends of the dumbbell handle. The interior element, which is a distinct and separate component of the invention, is used as a means for securing the weights to the handle by providing a tight tolerance with the handle. See Claims 1 and 3 of the Applicants' patent application. Noting that the prior art has not disclosed welding of an interior element to a dumbbell handle, still, the fact that a patent application discloses and claims a combination of features previously used in three separate devices, as stated by the Examiner in the present case, is, alone, not fatal to patentability. Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick, Co., 730 F.2d 1452, 1462 (Fed. Cir. 1984). "The claimed invention must be considered as a whole, and the question is

whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.” Id.

Finally, the Applicants’ invention is not obvious under 35 U.S.C. § 103(a), because the Landfair reference teaches away from the combination with Brice and Lefebvre that is propounded by the Examiner. In column 3, lines 16-31, the Landfair reference states, “Another attempted solution to the problem of securely attaching weighted heads to the bar is simply to weld the weighted heads in place. This approach is undesirable for several reasons.” The Landfair reference continues, in detail, to list and discuss numerous reasons why welding weights to the bar is undesirable. The Federal Circuit, in an unpublished opinion, has found that one of ordinary skill in the art would not be motivated to combine prior references where one of the cited references teaches away from the combination advanced by the Examiner. In re Rudko, Civ. App. No. 98-1505 (Fed. Cir. May 14, 1999) (unpublished). Thus, the Examiner’s rejection of claim 3 under 35 U.S.C. § 103(a) cannot be sustained.

#### **VI. SECTION 10 – REJECTION OF CLAIM 7**

The Examiner’s office action rejection of claim 7 under 35 U.S.C. § 103(a), as being unpatentable over Brice, U.S. Patent No. 5,628,716, in view of Lefebvre, FR 1,263,930, and further in view of Miller, U.S. Patent No. 3,022,073, is respectfully traversed. On page 7 of the Office Action, the Examiner states that Brice does not disclose “the weight resistance plate having a depression generally located on the inside surface to correspond to the protrusion on the handle,” as claimed by the Applicants in claim 7 of the application. The protrusion claimed by the Applicants serves to prevent

the weights from sliding to the center of the handle and comprises an annular flange as shown in the drawings. See the Specification of the Applicants' patent application. However, the Miller reference does not claim a protrusion, but instead, claims a pin 30 that forms a tight assembly to prevent the weights from rattling and to accommodate additional weight resistance plates (column 2, lines 33-38 and 50-63). Thus, both the structure and function of the Applicants' claimed protrusion and the pin of the Landfair reference are different.

In In re Fritch, 972 F.2d 1260 (Fed. Cir. 1992), the Federal Circuit Court of Appeals stated that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." The Applicants cannot determine if the prior art suggested the desirability of the modification because Lefebvre is written entirely in French and the Examiner has not provided the Applicants with an English-language translation of that reference. For these reasons, the Examiner's rejection of claim 7 under 35 U.S.C. § 103(a) cannot be sustained.

## **VII. SECTION 11 – REJECTION OF CLAIMS 8 AND 9**

The Examiner's office action rejection of claims 8 and 9 under 35 U.S.C. § 103(a), as being unpatentable over Brice, U.S. Patent No. 5,628,716, in view of Lefebvre, FR 1,263,930, and further in view of Pinard, FR 1,263,930, is respectfully traversed. On page 7 of the Office Action, the Examiner states that the Applicants' invention is disclosed by Brice in view of Lefebvre "except for the geometric shape of the end of the handle being generally rectangular (claim 8); [and] the geometric shape [being] formed



by cutting sides lengthwise into the end of the handle (claim 9).” The Examiner also states that Pinard discloses the use of a handle having a polygonal geometric cross-section and weight plates with complementary shaped openings to allow the ends of the handle to fit into the weight plates, thereby preventing rotation of the weight plates on the ends of the handle. The Examiner concludes that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the handle ends and weight plate openings of Brice as modified by Lefebvre with corresponding polygonal shapes as taught by Pinard, so that the weight plates do not rotate relative to the handle ends.” Respectfully, the Applicants believe that the Examiner has erred in relying upon hindsight to arrive at the determination that the Applicants’ invention is obvious in view of the cited prior art references.

The Federal Circuit has determined that “[i]t is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” In re Fritch, 972 F.2d 1260, 1266 (Fed Cir. 1992). In rejecting claims 8 and 9, the Examiner has done just that; that is to say, the Examiner has used the Applicants’ claims as a template to stitch together numerous teachings from the prior art to find the Applicants’ invention obvious under 35 U.S.C. § 103(a). In addition, the Applicants cannot determine if the prior art suggested the desirability of the modification because Lefebvre is written entirely in French and the Examiner provided only an English-language abstract for Pinard rather than the entire reference document. The Examiner has not provided the Applicants with an English-language translation of the Lefebvre and Pinard references as is required by §706.02 of

the M.P.E.P. Thus, in light of the Federal Circuit's holding in In re Fritch as well as the lack of English-language translations of the French prior art references, the Examiner's rejection of claims 8 and 9 as being obvious under 35 U.S.C. § 103(a) cannot be sustained.

#### **VIII. SECTION 12 – REJECTION OF CLAIM 10**

The Examiner's office action rejection of claim 10 under 35 U.S.C. § 103(a), as being unpatentable over Brice, U.S. Patent No. 5,628,716, in view of Lefebvre, FR 1,263,930, and further in view of Martinez, U.S. Patent No. 5,484,367, is respectfully traversed. The Martinez reference does not disclose an interior element as claimed by the Applicants as a means for securing the weights to the dumbbell handle.

In In re Fritch, 972 F.2d 1260 (Fed. Cir. 1992), the Federal Circuit Court of Appeals stated that “[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” The Applicants cannot determine if the prior art suggested the desirability of the modification because Lefebvre is written entirely in French and the Examiner has not provided the Applicants with an English-language translation of that reference. Therefore, the Examiner's rejection of claim 10 under 35 U.S.C. § 103(a) cannot be sustained.

#### **IX. SECTION 13 – REJECTION OF CLAIMS 12 THROUGH 17**

The Applicants hereby respectfully traverse the Examiner's office action rejection of claims 12 through 17 under 35 U.S.C. § 103(a), as being unpatentable over Brice, U.S. Patent No. 5,628,716, in view of Lefebvre, FR 1,263,930, and further in view of Hahn,

U.S. Patent No. 2,452,458. As stated by the Examiner on page 10 of the Office Action, the combination of these references does not disclose the interior element as claimed by the Applicants. Moreover, in In re Fritch, 972 F.2d 1260 (Fed. Cir. 1992), the Federal Circuit Court of Appeals stated that “[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” The Applicants cannot determine if the prior art suggested the desirability of the modification because Lefebvre is written entirely in French and the Examiner has not provided the Applicants with an English-language translation of that reference. The drawings for Lefebvre do indicate clearly that an interior element, such as that claimed by the Applicants, is disclosed. Thus, the Examiner’s rejection of claim 12 through 17 under 35 U.S.C. § 103(a) cannot be sustained.

**X. SECTION 14 – REJECTION OF CLAIMS 1, 6, AND 18**

Finally, the Examiner’s office action rejection of claims 1, 6, and 18 under 35 U.S.C. § 103(a), as being unpatentable over Thorne, U.S. Patent No. 5,266,069, in view of Lefebvre, FR 1,263,930, is respectfully traversed. As stated by the Examiner on page 11 of the Office Action, the combination of these references does not disclose the interior element as claimed by the Applicants. Moreover, in In re Fritch, 972 F.2d 1260 (Fed. Cir. 1992), the Federal Circuit Court of Appeals stated that “[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” The Applicants cannot determine if the prior art suggested the desirability of the

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modification because Lefebvre is written entirely in French and the Examiner has not provided the Applicants with an English-language translation of that reference. The drawings for Lefebvre do indicate clearly that an interior element, such as that claimed by the Applicants, is disclosed. Thus, the Examiner's rejection of claim 1, 6, and 18 under 35 U.S.C. § 103(a) cannot be sustained.

If there are any additional charges, including extension of time, please bill our Deposit Account No. 13-1130.

Respectfully submitted,



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